

REMARKS

Reconsideration and further examination of the subject application, in view of the remarks below, are respectfully requested.

Status of Claims

Claims 1-33 are pending in the application. Each of these claims is under consideration.

Examiner's Response to Arguments

The Office Action opens with a statement that Applicants' response filed April 3, 2006, has been considered, but the response is not persuasive. The rationale accompanying this statement is that "Applicants' claim 1 remains so broad[]....The composition basically consist [sic] of a polyester and an additive." The Examiner's rationale, however, is curious for a couple of reasons.

First, it doesn't appear to address the argument Applicants presented against the obviousness rejection based on U.S. Patent Appl. Publ. No. 2004/0127609 (US '609) in the previous Office Action. The argument presented was that US '609 cannot be applied against the subject application under § 103(a), because § 103(c)(1) prohibits it. US '609 only qualifies as prior art under § 102(e), (f), or (g). Since it is owned or subject to an obligation of assignment to Eastman Chemical Company at the time the invention was made, the same assignee as that of the subject application, § 103(c)(1) prohibits its use for obviousness purposes. Thus, the scope of Applicants' claim 1 is not relevant to the analysis.

Second, the Examiner's rationale is not a fair assessment of the claim. Claim 1 has at least two features that make the composition unique, as well as particularly useful for being processed by calendering at high production rates. The claim specifies that the polyester has both a branching monomer residue and an inherent viscosity (I.V.) within a certain range. As seen in Examples 1-5 and Tables 3-7 of the subject application, polyesters containing the combination of a branching monomer plus a low I.V. (Example 5) exhibit the lowest roll resistance (Table 4), decreased bearing pressure between calender rolls at each roll speed (Table 5), the lowest temperature increase as the roll speed was increased (Table 6), and no melt fracture at the higher roll speeds (Table 7). Such properties make the polyester, when accompanied by an appropriate release agent, particularly suitable for calendering at high speeds.

Thus, it is neither fair nor accurate to say that Applicants' claim "basically consist of a polyester and an additive."

Claim Rejection – 35 U.S.C. § 103

Turning now to the rejection in the Office Action, claims 1-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,399,661 to Borman. For the following reasons, this rejection should be withdrawn.

Borman does not disclose or suggest each feature of the present claims. For example, it does not disclose or suggest a polyester having a crystallization half-time from a molten state of at least 5 minutes, much less 30 minutes. On the contrary, Borman's copolyester compositions are said to be "highly crystallizable and crystallize rapidly." Col. 1, ll. 16-17 (emphasis added). Rapidly crystallizing copolyester compositions would not be expected to be very suitable for calendering.

Moreover, Borman doesn't mention anything about its copolyester having the combination of branching agents as well as a low I.V. Nor does Borman mention calendering or an additive effective to prevent the polyester from sticking to calendering rolls. Thus, Borman fails to disclose or suggest each feature of the present claims.

Accordingly, there's no *prima facie* case of obviousness, and the rejection should be withdrawn.

Conclusion

In summary, Applicants believe the application to be in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the rejection(s), remove all rejections, and pass the application to issuance.

Respectfully submitted,

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